Supreme Court, U.S.
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IN THE

Supreme Court of the United States

SHEN MANUFACTURING CO., INC.,

Petitioner,

v.

THE RITZ HOTEL LIMITED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Whether The Federal Circuit and TTAB erred in applying the first DuPont factor by failing to consider the commercial impression and connotation of an Opposer's mark RITZ for similar and identical goods where the commercial impression of the mark of an Applicant, which is known as "The RITZ", was found to have a commercial impression based on fame derived from the same term.

Whether the TTAB and Federal Circuit erred by failing to consider the connotation and commercial impression of the Opposer's mark RITZ, while imparting a commercial impression for Applicant's RITZ mark based on Applicant's fame for Applicant's RITZ HOTEL services.

Whether the TTAB and Federal Circuit erred by attributing a connotation for Applicant's mark based on the term containing the Opposer's mark, and not according a similar connotation or commercial impression consistent with an English dictionary definition for the word RITZ used by Opposer for similar goods.

Whether the Federal Circuit erred by limiting its consideration of the strength of an Opposer's mark to whether the Opposer's mark was famous.

Whether the Federal Circuit erred in considering the fame of Applicant, whose name contains the Opposer's mark, without considering the reverse confusion likely to occur where Opposer is a prior user of the mark.

Whether the Federal Circuit erred in deviating from its own precedent when it narrowed an applicant's listed goods description by imposing limitations on the goods that did not appear in the goods description.

Whether, under APA Section 706(2)(E), judicial review of a Trademark Trial and Appeal Board ("TTAB") decision is possible when the TTAB opinion is indiscernible as to what evidence was properly of record.

Whether the Federal Circuit, in judicial review capacity under APA Section 706(2)(E), can make a factual conclusion as to the strength of a trademark when the TTAB failed to undertake such an analysis by not making the requisite factual findings or providing the pertinent rationale in light of the legal standard for strength.

Whether, under the APA Section 706(2)(E) substantial evidence standard of review, the Federal Circuit can reverse a finding of the TTAB simply because the Federal Circuit is able to draw an inconsistent conclusion from the facts as set out by the TTAB.

Under APA 706(2)(E), can the Federal Circuit make a factual finding as to the connotation of a trademark when the TTAB's opinion is silent as to the pertinent facts and the legal standard to be employed for such a determination.

PARTIES TO THE PROCEEDING AND RULE 29.6 STATEMENT

Petitioner Shen Manufacturing Company, Incorporated, ("Shen") is a Pennsylvania corporation. There are no parent corporations or publicly held companies that hold ten percent or more of the stock of Shen Manufacturing Company, Incorporated.

Respondent, The Ritz Hotel Limited, is a limited corporation under the laws of the United Kingdom.

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Petitioner, Shen Manufacturing Company Incorporated ("Shen"), by and through its attorneys, respectfully petitions for a writ of *certiorari* to review the judgment of the Court of Appeals for the Federal Circuit ("the Federal Circuit").

OPINION BELOW

The opinion of the Federal Circuit is reported at 393 F.3d 1238 and reproduced in Petitioner's Appendix (hereinafter "App.") at 1a-15a. The order denying panel rehearing and denying rehearing *en banc* is reported at 2005 U.S. App. LEXIS 5032 and is reproduced in App. at 34a-35a.

STATEMENT OF JURISDICTION

Judgment of the Federal Circuit was entered on December 17, 2004, and the order denying panel rehearing and denying rehearing *en banc* issued on March 8, 2005. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

STATUTES INVOLVED

Section 13 of the Lanham Act, 15 U.S.C § 1063 sets forth the grounds for opposing a trademark application before the United States Patent and Trademark Office. The controlling portion of section 13 provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register, . . . may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office. . . ." 15 U.S.C. § 1063 (2004). The entirety of section 13 is set forth in App. 41a-42a.

Section 2 of the Lanham Act, 15 U.S.C. § 1052, sets forth a basis for opposing a trademark application pending before the United States Patent and Trademark Office. The controlling portions are set forth below and section 2 in its entirety, is set forth in App. 37a-40a.

> No trademark in which the goods of the applicant may be distinguished from the goods of others shall be

> refused registration on the principal register on account of its nature unless it –
>
> . . .
>
> (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. . . .

15 U.S.C. § 1052 (2004).

Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), provides a registration is *prima facie* evidence.

> A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

15 U.S.C. § 1057(b) (2004).

Section 5 of the Administrative Procedure Act, 5 U.S.C. § 706, circumscribes the Federal Circuits scope of review:

> 706. Scope of review
>
> to the extent necessary to decision and when presented, the reviewing court shall decide all the relevant questions of the law, interpret constitutional and statutory provisions, and determine the meaning

or applicability of the terms of an agency action. The reviewing court shall—

. . .

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

. . .

(E) unsupported by substantial evidence in a case . . . review on the record of an agency hearing provided by statute. . . .

5 U.S.C. § 706 (2004). App. 36a-37a.

STATEMENT OF THE CASE

The Proceeding Below

In 1984 and 1985 Ritz Hotel Limited ("RHL" or "Applicant") filed seven trademark applications with the United States Patent and Trademark Office ("USPTO") seeking to register marks consisting of or containing the word RITZ for various goods and services. Shen Manufacturing Company, Incorporated ("Shen" or " Petitioner" or "Opposer") filed seven Notices of Opposition opposing the applications on the basis that RHL's use of its proposed marks in connection with its goods and services is likely to cause confusion with Shen's RITZ marks. A summary of Shen's RITZ marks is presented *infra* at App. Tables II and IIa. A summary of the seven oppositions is presented *infra* at App. Table I. By order of the Trademark Trial and Appeal Board ("TTAB" or "Board") dated April 25, 2001, the seven oppositions were consolidated. The Board deferred ruling on evidentiary objections on October 2, 2002. App. 24a-33a. On August 7, 2003, the Board sustained Opposition Nos. 72,818, 74,778, and 75,003, and the remaining Opposition Nos. 71,706, 72,817, 73,756, and 74,517 were dismissed. App. at 16a-23a.

Upon appeal, the Federal Circuit affirmed the decision dismissing Opposition Nos. 71,706, 73,756, and 74,517 and

reversed the decision sustaining Opposition Nos. 72,818 and 75,003. App. at 2a. The application of Opposition No. 72,817 was expressly abandoned by Applicant RHL, and the TTAB decision in Opposition No. 74,778 was not appealed by RHL. This being the case, no ruling was made on these Oppositions by the Federal Circuit. The Federal Circuit denied a petition for rehearing and rehearing *en banc* on March 8, 2005. App. 34a-35a.

STATEMENT OF THE FACTS

The appeal to the Federal Circuit from the TTAB involves five Oppositions, Nos. 71,706, 72,817, 73,756, 75,003 and 74,517 ("the Oppositions"). Table I provides a summary of the oppositions at issue. App. 43a-46a. Tables II and IIa provide a summary of the Opposer Shen's various RITZ marks asserted in these proceedings. App. 47a-48a. Table IIb of the Appendix to this petition contains a non-exhaustive list of goods sold by Shen in commerce under its common law RITZ marks. App. 49a.

It is undisputed that Shen is the senior user of RITZ in U.S. commerce — since 1892 with a line of household cleaning cloths that originally included dishtowels and cleaning cloths. App. 2a. As of the close of discovery, in 1999, it was established that Shen sold its products in every state of the nation and in many foreign countries and Shen's goods expanded from cloths to other household goods, such as, kitchen towels, aprons, napkins, oven mitts, kitchen gloves, chef's clothing and protective wear, bath towels, seat cushions and shower curtains. Shen's RITZ mark expanded into a RITZ PRO series, a RITZ STERLING series, RITZ SUPREME, RITZ DESIGN LINE, RITZ ESSENTIALS, RITZ ROYALE, and RITZ CLASSICS. Shen's RITZ products are found in department stores, houseware stores, bed, bath and linen stores, discount stores, and others. Shen's products have a presence on Fifth Avenue in New York City as well as within the food service industry, trade shows and hotel/motel institutional shows. It is also clear that other

than perhaps a drabble of shower curtains, there is absolutely no evidence of record that RHL has sold any of the goods listed in its application in U.S. commerce under the proposed marks at issue. No survey evidence of connotation was offered by either party.

The Respondent, Ritz Hotel Limited, is a limited corporation under the laws of the United Kingdom and maintains a hotel in Paris, France. Its United States presence is entirely by means of travel publications and other publications discussing a hotel in Paris, France. With the possible exception of some shower curtains in the early 1980's, no goods are sold under RHL's proposed marks of the Oppositions. Applicant RHL now seeks to transplant its alleged fame for a hotel in Paris, France to household goods in the United States and cooking and kitchen related goods and services in the United States. Such goods and services include floor mats and matting, linoleum for covering existing floors, wall coverings made of vinyl and plastic, dinner plates, saucers, household brushes, sponges, steel wool and household glassware, food services including instructions in cooking, and meal preparation for chefs, and shower curtains.

Other than these facts regarding its hotel in Paris, RHL offers nothing by way of facts relating to the products they propose to use in connection with a RITZ mark.

THE TRADEMARK TRIAL AND APPEAL BOARD'S DECISION

Regarding the merits of the Oppositions, the Trademark Trial and Appeal Board focused on two considerations, the similarities of the marks and the similarities of the goods, to undertake its likelihood of confusion analysis. App. 19a. The Board sustained the first two oppositions, both for the typed drawing RITZ for providing courses of instruction in cooking, meal preparation, wine selection (Ser. No. 73/499, 080, Op. No. 72,818) and for threads for use in textiles (Ser. No. 73/549, 463, Op. No. 74,778). App. 20a.

First considering the marks, the Board found that they were essentially identical and, because the marks were identical, contemporaneous use by different parties can lead to the assumption that there is a common source even where the goods and services are not competitively or intrinsically related. App. 19a-20a. The Board went beyond this and found that "certain of Opposer's goods are clearly related to providing courses of instruction in cooking and meal preparation, and threads for use in textiles." The Board even went painstakingly further in developing the rationale supporting the finding. App. 20a. The Board also made a finding, regarding threads for use in textiles, that regardless of how sophisticated the purchaser is, no degree of sophistication would enable even a professional to distinguish between essentially identical marks. *Id.* The Board made no findings other than a conclusion that the purchaser would be sophisticated.

Turning to RHL's Application Ser. No. 73/572,795 (Op. No. 75,003) for THE RITZ KIDS in typed drawing form for goods including gloves, the Board found that a likelihood of confusion existed with Opposer's RITZ and simple diamond design mark. App. 21a. Further articulating its findings, the Board stated that the application at issue included "gloves" of all types and was not limited in any way to specific gloves. App. 21a. The Board next found that a mitt is defined as a type of glove by referring to the dictionary. *Id.* Based on those factual findings the Board found that the marks were legally identical, and the goods were in part legally identical. *Id.* The Board also found that the word THE and the word KIDS were insignificant in contrast to the RITZ term. *Id.*

Turning to Shen's opposition to RHL's applications to register RITZ PARIS and design for dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, household sponges, household brushes, steel wool, and household glassware (Ser. No. 73/518, 941, Op. No. 73,756), and for rugs, carpets, floor mats and matting, linoleum for

covering existing floors, and wall covering made of vinyl and plastic (Ser. No. 73/518, 946 Op. No. 74,517), the Board noted that the marks were distinctly different in appearance, pronunciation, and especially meaning. App. 22a. The Board found that RHL's mark conjures up a hotel in Paris when considering RHL's proposed goods, household sponges and brushes, even though the Board found that they were factually similar in terms of their functions with Shen's goods. *Id.* The Board made no finding on the meaning or the commercial impression of Opposer Shen's RITZ marks. *Id.*

The Board, turning next to Shen's opposition in RHL's Application Ser. No. 73/514,805 (Op. No. 71,706) for PUTTING ON THE RITZ for shower curtains, noted that Shen's use of shower curtains was subsequent to RHL's alleged use of shower curtains, but Shen had priority for bathroom towels. *Id.* The Board then found, based on its finding that bathroom towels and shower curtains are related goods, that Shen was the senior user. Nevertheless, the Board found no likelihood of confusion. *Id.*

The Board's final consideration was of Shen's opposition to RHL's application for the mark CESAR RITZ (Ser. No. 73/489, 264, Op. No. 72,817) for cooking courses, where the Board found no likelihood of confusion stating that the marks were sufficiently distinct from one another, particularly due to the presence of CESAR as the first term of RHL's mark. App. 23a.

THE FEDERAL CIRCUIT'S DECISION

In a unanimous decision, the Federal Circuit made the following findings. Beginning with Op. No. 71,706 for RHL's PUTTING ON THE RITZ, a mark for shower curtains, the Federal Circuit agreed with the Board's finding that Shen's bathroom towels and RHL's shower curtains are related goods and that the degree of similarity necessary to support a likelihood of confusion concomitantly declines. App. 7a-8a. Regarding the similarity of the marks, the Federal Circuit found that the mark

PUTTING ON THE RITZ, when evaluated as a whole, conveys a strong commercial impression.

> It conjures images of fancy, even swanky, ladies in full length gowns and gentlemen in tails and top hats congregating in a large Art Nouveau restaurant where an orchestra is about to start. This image, one of comfort, sophistication and wealth, resonates strongly with the buying public, leaving them with an impression unlike that from Shen's RITZ mark, which, when used on kitchen textiles, invokes images, if any, of cleaning, cooking or manual labor generally.

App. 8a-9a.

The Federal Circuit came to this conclusion without any factfinding being made by the TTAB on the meaning and commercial impression of Opposer Shen's RITZ marks and by ignoring the dictionary. Also, without any articulation by the Board, the Federal Circuit provided that the two marks also differed in sound and appearance stating that the RITZ mark contains other words in addition to RITZ making both its visual appearance and pronunciation longer. App. 9a. The Federal Circuit then affirmed the Board's decision finding no likelihood of confusion. *Id.*

Turning to Op. Nos. 73,756 and 74,517 for RHL's RITZ PARIS and design, the Federal Circuit affirmed the Board's dismissal of the oppositions. The products that were covered included dinnerware, cups, plates, saucers and drinking glasses, and cleaning items such as steel wool and sponges, and various types of floor coverings including carpets and rugs and vinyl wall coverings. The Federal Circuit provided:

> The crest, ribbon and reference to Paris collectively give the commercial impression of royalty, old-world tradition and continental elegance, which differs from the more mundane impression imparted by Shen's RITZ mark.

App. 10a. This finding was never made by the TTAB and was first made by the Federal Circuit. The Federal Circuit went on to make another factual finding not touched upon by the Board that Shen's mark generally appears as simple block lettering or block lettering centered in a diamond. *Id.* The Federal Circuit went on to affirm the Board's decision stating that Applicant's mark RITZ PARIS and design differed from Opposer's RITZ marks. App. 11a.

The Federal Circuit next turned to Op. No. 72,818 and reversed the Board's decision sustaining that opposition. The opposition related to RHL's application for RITZ for cooking and wine selection classes. The Federal Circuit agreed with the Board's finding that the marks are identical and focused its attention on the relatedness of the goods. App.11a.

The Federal Circuit disagreed with the Board's factual finding that RHL's cooking classes are related to Shen's kitchen textiles. App. 11a-13a. In its analysis, the Federal Circuit provided that the test is not that the goods and services must be related if used together, but merely that such a finding is part of the underlying factual inquiry as to whether the goods and services at issue can be related in the mind of the consuming public as to the origin of the goods. App. 11a. The Federal Circuit went on to state that the relationship between cooking classes and kitchen textiles is more akin to the relationship between restaurant services and beer, where no likelihood of confusion was found, rather than the relationship between snack foods and dog treats, which were found to be related. App. 11a-12a. The Federal Circuit further went on to state that aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from the same source, and as a result, the Board's finding of relatedness is not supported by substantial evidence. App. 13a. The Federal Circuit provided that since cooking classes and kitchen textiles are not related, the ultimate conclusion as to likelihood of confusion is reversed. *Id.*

Also, notably, the Federal Circuit made a factual finding as to the strength/weakness of Shen's collection of RITZ trademarks, but considered only that Shen's mark RITZ, since it was not famous, was weak. App. 13a, 6a-7a. The Board never considered the strength of Shen's mark whatsoever, other than concluding that Shen's RITZ marks are not famous. App. 6a-7a.

The Federal Circuit turned next to Op. No. 75,003 for THE RITZ KIDS, which was sustained by the Board and reversed by the Federal Circuit. The Federal Circuit stated that it refused to sanction what it perceived as the Board's dissection of RHL's THE RITZ KIDS mark, providing a finding of fact, which was contrary to the Board's finding, that "THE" has elevated significance because of the well-known manner in which people refer to RHL, and also making a finding of fact, which was contrary to the Board's finding, that the term "THE" operates as an indicator of source of RHL's mark, even though it has diminished importance in most other marks. App. 13a-14a.

The Federal Circuit also made a finding of fact that it is unlikely that consumers would mistakenly believe that Shen, a company that actually manufactures products and has sales, has expanded into children's clothing, where RHL, a hotel in Paris which has offered no evidence of sales of goods or services in the United States, is more likely to make children's clothes. App. 14a.

The Federal Circuit went on to make another finding that the pronunciation of THE RITZ KIDS sounds like "the rich kids" leaving the impression of wealth, a concept tied strongly to RHL and not associated in anyway with Shen for its mark. This also was not in any way found by the Board or made of record by the Board. *Id.*

The Federal Circuit also reversed the Board's finding that gloves are related to barbeque mitts as not being supported by substantial evidence. *Id.* The Federal Circuit went on to state

that the mere fact that both barbeque mitts and gloves are worn on the hands simply does not support a finding that consumers would associate these products with a common source. *Id.* Apparently the standard of review has changed. The Federal Circuit summed up this opposition stating that because THE RITZ KIDS is not similar to RITZ and gloves are not related to barbecue mitts, it reversed the Board's decision sustaining Op. No. 75,003. *Id.* It is important to note that there is no evidence of record that Applicant RHL has ever manufactured or marketed any type of gloves. Moreover, RHL chose not to restrict the goods listing to a specific type of glove, and there are no facts of record restricting or narrowing the gloves type. Thus, it can be just as likely that RHL seeks to produce heat resistant gloves under the mark of THE RITZ KIDS.

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT FAILED TO FOLLOW EXISTING PRECEDENTS OF THIS COURT, THE FEDERAL CIRCUIT, AND IS IN CONFLICT WITH THE SECOND CIRCUIT ON IMPORTANT ISSUES OF TRADEMARK LAW.

Certiorari should be granted to resolve issues of trademark law regarding the likelihood of confusion analysis, and in particular, (1) evaluation of the similarity of marks, (2) the strength of the marks, (3) a likelihood of reverse confusion, and (4) failure to limit an applicant's goods to the description in its application.

A. The Federal Circuit and TTAB erred in applying the first DuPont factor by failing to consider the commercial impression and connotation of an Opposer's mark RITZ for goods similar or identical to Applicant's goods, where the commercial impression of the mark of Applicant, which is known as " The RITZ", was found to have a commercial impression based on fame derived from the same term.

The Federal Circuit law provides that all relevant facts pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar. *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357, 56 U.S.P.Q.2d 1351, 1354 (Fed Cir. 2000). However, in the present case, the Federal Circuit did precisely what it previously said it may not do, namely not considering facts relating to the connotation and commercial impression of Shen's RITZ mark.

After finding that the parties' goods were essentially the same, i.e. household cleaning products, the TTAB never made a finding on the meaning of Opposer's RITZ mark. While The TTAB determined that the Applicant's RITZ PARIS and design marks conveyed both (1) the meaning of a hotel, and (2) the Applicant's hotel, this is at best only half of what relevant facts are needed when making a comparison of two marks to determine whether the marks have similar meanings. Without all relevant facts (which include the meaning of Opposer's mark), a finding on similarity or dissimilarity cannot be made.

Precedent looks to the meanings of the term, which here is RITZ. The term RITZ has a regular meaning associated with it. The dictionary meaning for "ritzy" was part of the record before the TTAB. The English language meaning of the term is ostentatious or fancy, which was derived from the characteristics of the Applicant's hotel. The ordinary accepted meaning of the

term RITZ, when considering Opposer's RITZ marks, was ignored by both the TTAB and the Federal Circuit. When the meaning of Applicant's mark PUTTING ON THE RITZ was considered, the meaning of RITZ was consistent with the dictionary definition, again a connotation of fancy. However, even if the term RITZ and RITZY are derived from or are characteristic of the Applicant's hotel, the term RITZ when used by Opposer, must also be considered to have a commercial meaning or impression corresponding to the ordinary dictionary meaning. The TTAB applied no meaning at all to Opposer's RITZ mark, and the Federal Circuit applied a meaning that contrasted drastically from the dictionary meaning for the word. The commercial impression of Opposer Shen's mark RITZ, should not be precluded from the ordinary impression of the term. Applicant's mark, however, was given the benefit of the dictionary meaning, since, Applicant "The Ritz Hotel" is that very landmark from which the generic adjective "ritzy", part of the English language, has been derived.

It is untenable to hold that the Applicant's RITZ PARIS design marks bring to mind a hotel in Paris, France whereas Shen's RITZ marks (including the word RITZ alone) do not conjure up the same image. Similarly, it is equally untenable to hold the same for PUTTING ON THE RITZ. Although the Board made no finding of fact regarding the connotation of Shen's RITZ marks, the Federal Circuit attributed a connotation of mundane images of cooking, cleaning and manual labor generally. This unsupported conclusion could not be further from reality. A multitude of dictionary references clearly show that the term "RITZ", standing alone,[1] is commonly understood as *elegant or ostentatious*, and the common idiom associated with "RITZ" is "*put on the Ritz*". Moreover, the dictionary definitions

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[1] Shen's registered mark RITZ of Registration No. 2,288,326 is a trademark not restricted to any special form and has a scope of coverage that extends to all reasonable manners in which the mark could be depicted. Trademark Rule 2.51(e), 37 C.F.R. § 2.51(e); *Phillips Petro v. C.J. Webb*, 442 F.2d 1376, 170 U.S.P.Q. 35 (C.C.P.A. 1971).

of the term "RITZ" (standing alone) directly reference Applicant's hotel as well as its founder, César Ritz. *Id.*

For instance, one dictionary defines RITZ as "Elegant, often ostentatious display." THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2000). Another dictionary defines RITZ as "put on the ritz, *informal* to live in elegance . . . ." RANDOM HOUSE UNABRIDGED DICTIONARY (1997). Yet another dictionary states RITZ as ". . . a name associated with luxury hotels, from the Swiss hotel owner César Ritz (1850-1918). COMPACT OXFORD ENGLISH DICTIONARY (2004); *see also*, WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY OF THE ENGLISH LANGUAGE (1969).

If the "similarity of marks" test is properly applied, there is no way to avoid a finding that the marks at issue are confusingly similar. The similarity in connotation between the marks at issue is resounding.[2] The Federal Circuit was sufficiently convinced that Applicant's proposed marks bring to mind Applicant's hotel, or images of comfort, sophistication and wealth, or royalty, old world tradition and continental elegance. Similarly, adjudicative facts show that the commercial connotation of Shen's mark "RITZ" is commonly understood as referring to the hotel, or something ostentatious and elegant.[3] The similarity in connotation simply cannot be denied.

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[2] Shen's RITZ marks, including RITZ ROYALE and RITZ STERLING, undeniably establish a likelihood of confusion especially in view of the Federal Circuit's attribution to a connotation of royalty as a basis for distinction.

[3] The Board made no finding regarding the connotation/meaning of Shen's RITZ marks. See *infra* Part II for discussion on the Federal Circuit's factfinding in violation of the APA.

B. The TTAB and Federal Circuit erred by failing to consider the connotation and commercial impression of the Opposer's mark RITZ, while inparting a commercial impression for Applicant's RITZ marks based on Applicant's fame for Applicant's Ritz Hotel services.

The Court precedent is clear that the first DuPont factor involves an analysis of similarity of the appearance marks, sound of the marks, and meaning of the marks as well as the commercial impression. The Federal Circuit has considered that the test is satisfied where the Board considers both the meaning and the commercial impression. *Palm Bay Imports, Inc. v. Maison Fondee en 1772*, 396 F.3d 1369, 1371-72 (Fed. Cir. 2005). In the instant case, the TTAB only considered the connotation with respect to the Applicant's RITZ marks (*e.g.*, RITZ PARIS and PUTTING ON THE RITZ) but not Opposer Shen's RITZ marks. The instant case is not unlike *Hewlett-Packard v. Packard Press, Inc.*, 281 F.3d 1261, 1266-67 (Fed. Cir. 2002), where the Federal Circuit determined that the commercial impression was similar, since consumers would be aware of the Applicant's connection with technology – a derivation of a word appearing in the mark at issue. (Compare PACKARD TECHNOLOGIES with HEWLETT PACKARD) In the instant case, neither a meaning nor commercial impression for RITZ, the Opposer's mark, was considered by the TTAB, and the Federal Circuit deemed RITZ to be mundane (though it found "The RITZ" to be renown). Had the meaning and commercial impression of Opposer's mark RITZ been considered, RITZ would have been found to be an ordinary term in the English vernacular having unquestionably the same commercial impression which the TTAB and Federal Circuit deemed Applicant and its marks to possess. To consider the RITZ HOTEL to be so famous, but that when RITZ appears without the word "The" or "Hotel" as it does in Opposer's RITZ mark and one of Applicant's own marks, to not call to mind the famous landmark hotel or its renown fancy character, is clear error.

The first factor therefore, was not properly considered, and the case raises serious questions whether a connotation and commercial impression can be determined to be something other than the term's accepted meaning.

C. The TTAB and Federal Circuit erred by attributing a connotation for the Applicant's mark based on the term containing the Opposer's mark, and not according the connotation or commercial impression for the word RITZ used by Opposer for similar goods consistent with an English dictionary definition.

By failing to perform a complete analysis in determining similarity of the marks, the TTAB and Federal Circuit failed to fully consider the impact of Applicant's fame, which is clear error in view of the precedent established by *Packard Press,* 227 F.3d at 1357. The TTAB considered the connotation of the Applicant's mark to be based on the Applicant's world famous RITZ HOTEL. Applicant attempted to prove its RITZ HOTEL, or THE RITZ as it is also known, has received world-wide fame, and the TTAB acknowledged and considered this. However, consideration of fame for RITZ, cannot stop at the Applicant's mark which was for use with, *inter alia*, household cleaning products, but must also be taken into account when evaluating the commercial impression of the Opposer's RITZ mark and the household cleaning products sold thereunder. The TTAB's failure to consider the commercial impression of Opposer's mark and Federal Circuit's departure from its own precedent, especially here, where there is a dictionary meaning of record for at least the derivation of RITZ, namely "ritzy", is reversible error.

The Federal Circuit in *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000), considered that when a famous mark is at issue, it is reversible error not to consider the scope of the goods/services to which fame may be attributed to be broader than the goods/services used with the famous mark. *Id.*

(vacating and remanding the TTAB decision). Similarly, in *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 355 (Fed. Cir. 1992), the Federal Circuit reversed the TTAB and held that had the TTAB conducted a correct assessment of the DuPont factors, which it clearly had not, the *fame of the mark* at issue should have *magnified the significance of the commercial impression similarities* of the respective marks at issue. In the present case, the fame which the TTAB and the Federal Circuit attributed to the Applicant's RITZ HOTEL, impermissibly limited the fame scope, and hence resulted in a misapplication of the first DuPont factor, since fame (of the Applicant or its mark) would be worth consideration. As the Federal Circuit admonished the TTAB for doing in *Kenner*, here, both the TTAB and the Federal Circuit attempted to consider the fame as a distinguishing factor of the Applicant's RITZ marks, when in fact, Applicant's fame for RITZ and Applicant's renown and connection with RITZ, should clearly, as in *Kenner*, have heightened the level of potential similarity between Applicant's mark RITZ and the RITZ marks of Opposer Shen, the senior user, especially where the goods of Applicant and Opposer both included household cleaning products.

D. The Federal Circuit erred by limiting its consideration of the Strength of an Opposer's mark to whether the Opposer's mark was famous.

The legal question of a mark's strength in a likelihood of confusion analysis has competing precedent. The Federal Circuit considers strength to be whether a mark is famous, whereas the Second Circuit considers the primary importance of a mark's strength to be the degree to which a mark is arbitrary, or conversely descriptive, of the goods or services. Under the Federal Circuit law applied in the instant decision below, a mark is a weak mark if it is not a famous mark. Under the Second Circuit law, a mark may be a strong mark without being famous.

The Federal Circuit law improperly equates the strength of a mark with the mark being famous. The Federal Circuit Court

of Appeals determined that Shen's Opposition was based on three (3) of the thirteen (13) DuPont factors, and determined that three (3) of the thirteen (13) DuPont factors under which a likelihood of confusion is considered were relevant in the instant case. Notably, the three factors which the Federal Circuit considered to be at issue were:

(1) the *strength* of the mark;

(2) the similarity of RHL's marks to Shen's RITZ mark; and

(3) the relatedness of the products covered by RHL's applications and those sold by Shen.

App. 3a.

However, when the Federal Circuit considered the relevant factor of strength of the mark, its consideration was limited to whether Shen's mark was famous:

(1) the alleged *fame* of Shen's RITZ mark;

(2) the similarity of the marks; and

(3) the relatedness of the goods.

App. 5a.

Since the Federal Circuit did not consider Shen's RITZ mark to be famous, it then concluded that the Shen RITZ mark was weak (". . . the weakness of Shen's mark lead us to dismiss Opposition No. 72,818"). App. 13a. The determination that Shen's mark was weak, was improper, and led to Shen's mark not being given the weight it should have under the likelihood of confusion analysis.

The Federal Circuit determined that the TTAB's failure to find Shen's mark famous was supported by substantial evidence. However, the Federal Circuit did not consider the strength of Shen's RITZ mark apart from whether the mark was famous.

The result is different when the Second Circuit law is applied. Under the Second Circuit law, Shen's RITZ mark is inherently distinctive as relative to the Shen goods. Shen's strong RITZ mark therefore is entitled to greater protection against the Applicant's mark. The Second Circuit, in considering likelihood of confusion in *Virgin Enters. v. Nawab*, 335 F.3d 141, 147 (2d Cir. 2003), applies a test which considers strength of the mark based on its arbitrary/descriptive character:

> The ***strength of a trademark*** encompasses two different concepts, both of which relate significantly to likelihood of consumer confusion. ***The first and most important is inherent strength, also called "inherent distinctiveness."*** This inquiry distinguishes between, on the one hand, inherently distinctive marks — marks that are arbitrary or fanciful in relation to the products (or services) on which they are used — and, on the other hand, marks that are generic, descriptive or suggestive as to those goods. The former are the strong marks. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The second sense of the concept of **strength** of a mark is "acquired distinctiveness," i.e., ***fame***, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition. See *TCPIP Holding Co. v. Haar Communications Inc.*, 244 F.3d 88, 100 (2d Cir. 2001) (describing these two concepts of strength); *Streetwise Maps*, 159 F.3d at 743 [(2d Cir. 1998)].

Shen's mark RITZ is arbitrary or in other words, inherently distinctive, as applied to the goods with which Shen uses the mark, as well as the Applicant's goods at issue here. Shen's mark was improperly considered weak by the Federal Circuit, which only concluded that Shen's RITZ mark was not famous. Unquestionably, Shen's mark RITZ would not be a weak mark under this Court's precedent, where the mark RITZ is an arbitrary fanciful term, Shen's sales of over five million dollars annually

of RITZ products, Shen's substantial advertising expenditures, Shen's long-standing use of RITZ for over 100 years, as well as the exposure to millions of customers and potential customers of Shen's RITZ mark annually as they shop in notable stores like Dayton Hudson Department Stores, Federated Department Stores, Bloomingdale's, Macy's, Burdine's, J.C. Penney's, Marshall Field, May Department Stores, Sears, K-Mart, Target, WalMart, and Bed, Bath and Beyond, where the RITZ products (with the RITZ mark in plain view) are on display.

Under the Second Circuit's law, the first and most important consideration of strength of a mark is whether the mark is inherently distinctive, which arbitrary marks like Shen's RITZ mark clearly are. *Id.* and see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 120 L. Ed. 2d 615, 112 S. Ct. 2753, 23 U.S.P.Q. 2d 1081, 1083 (1992). The Second Circuit also considers fame as the second sense of the strength concept. *Id.* However, unlike the Federal Circuit's law, under the Second Circuit's law, the lack of fame does not render a mark weak. Under the Second Circuit law, Shen's mark, though not famous, is still a strong mark, since it is arbitrary as applied to the goods.

The split between the Circuits has important implications for U.S. Trademark law, under which interstate commerce use is a prerequisite for acquisition of rights. In the Second Circuit, a mark, though not famous, may be strong, whereas in the Federal Circuit, a mark which is not famous, is inherently a weak mark. The partiality given by the Federal Circuit to large companies who have super marks, or who themselves are famous, like the Ritz Hotel Applicant here, places trademark owners, like Shen, who have unique inherently distinctive, arbitrary marks, at a disadvantage because their marks, though having the highest form of distinctiveness, may not be known by everyone everywhere.

Shen has federal trademark registrations for its RITZ marks. App. 47a. TTAB decision. The U.S. trademark statute governing registration of trademarks does not require secondary

meaning to be established unless the mark is merely descriptive. *See* 15 U.S.C. § 1052(e) and (f). In fact, the U.S. Supreme Court, in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q. 2d 1081, 1083 (1992) clearly discussed and applied the Second Circuit's classic formulation of increasing distinctiveness set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). The presumption of registration on the Principal Register, therefore, accords distinctiveness to a mark, like Shen's registered RITZ mark here. See 15 U.S.C. § 1057(b); and see *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (U.S. 2000). Moreover, in accordance with this Court's authority, the Shen RITZ mark would be inherently distinctive. The presumption of distinctiveness cannot be rebutted by the fact that the mark is not famous. For this to be the law, the Lanham Act would need to be rewritten. Since there is no presumption of fame when a mark is registered, *e.g.*, 15 U.S.C. § 1057(b), it cannot be the law to say that a mark must be a famous to be strong. The law is clear that strength of the mark is a consideration which may be arrived at independent of fame.

Accordingly, a writ from this Court is respectfully requested.

E. Failure to Consider Reverse Confusion in View of Applicant's Fame.

The fame consideration adopted by the TTAB and the Federal Circuit does not follow the DuPont analysis. When the DuPont analysis is considered, the fame to be taken into account under factor five (5) is Opposer's fame, *e.g.*, "the fame of the prior mark", and not the Applicant's fame. However, factor thirteen (13) permits other facts to be considered. Taking into account the fame of the RITZ HOTEL, Applicant's hotel, reverse confusion is unavoidable. In the present case, the TTAB found that, and attributed Applicant to have admitted that, Opposer Shen is a prior user of the mark RITZ. The Federal Circuit has improperly used the consideration of fame to favor a junior user Applicant, instead of recognizing the potential for reverse

confusion. In reverse confusion, the strength of the junior user's mark is crucial in establishing a reverse confusion claim. *Checkpoint Systems, Inc. v. Check Point Software Tech., Inc.*, 269 F.3d 270, 60 U.S.P.Q. 2d 1609 (3d Cir. 2001); *Dreamwerks Production Group v. SKG Studio*, 142 F.2d 1127, n.5, 46 U.S.P.Q 2d. 1561, n.5 (9th Cir. 1998). Given both the Federal Circuit's and TTAB's findings that Applicant's Ritz Hotel in Paris is famous, and one of the most renowned hotels in the world, it is clear that the senior user, Shen, will lose the value of the trademark, its product identity, corporate identity, control over its goodwill and reputation and the ability to move into new markets. *In re Shell Oil Co.*, 992 F 2d 1204, 26 U.S.P.Q. 2d 1687 (Fed. Cir. 1993); *Ameritech, Inc. v. Am. Info. Tech. Corp.*, 811 F.2d 960, 1 U.S.P.Q. 2d 1861 (6th Cir. 1987). Given the overwhelming renowned and defined association of the term RITZ with The Ritz Hotel, a consumer who purchases Shen's RITZ branded products, especially since the marks of both parties are either identical or have identical commercial connotations, is likely to make the association with The Ritz Hotel. There is no reason that Shen's houseware products sold under the mark RITZ, which is identical to or has the identical commercial connotation as RHL's proposed marks, would not be deemed by consumers to originate from The Ritz Hotel, whose proposed marks are for products found by the Federal Circuit and the Board to be related to various Shen RITZ products.

If the Applicant's fame for its Ritz Hotel is permitted to be considered, the fame makes it even more likely that confusion will be clear when consumers are confronted with the term RITZ.

F. The Federal Circuit impermissibly narrowed Applicant's goods description in order to find no likelihood of confusion.

The Federal Circuit diverted from the actual goods description of the application and imposed limitations on the Applicant's goods that are not recognized under the Lanham Act.

The Applicant's goods description in its application for the THE RITZ KIDS is broad enough to cover barbeque mitts. Gloves protect from the cold, and gloves also protect from hot surfaces or items. The Federal Circuit observed that Shen's RITZ glove is a barbeque mitt, not simply a mitt. However, the RHL Applicant's description of gloves and hats is silent, leaving out what the Federal Circuit attributed to the goods description, namely, functioning to keep warm or add style. Here, the Federal Circuit directly contradicted its axiomatic precedent governing a trademark goods description in an application.

> The authority is legion that the question of registrability of an applicant's mark ***must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods***, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys., Inc. v. Houston Computer Services, Inc., 918 F.2d 937, 942 (Fed. Cir. 1990) (citations omitted) (emphasis added).

Such a construction by the Federal Circuit is not only contrary to its own established precedent, but also opens the door for endless argument and conjecture by future applicants who will claim, without adequately amending the identification of goods, that the "widget" they propose to use in commerce is a different type of widget than that of the prior/senior user.

II. CERTIORARI SHOULD BE GRANTED BECAUSE TTAB ADJUDICATION AND THE REVIEW OF SUCH BY THE FEDERAL CIRCUIT ARE ESSENTIALLY STANDARDLESS, IN VIOLATION OF THE ADMINISTRATIVE PROCEDURE ACT.

Certiorari should be granted because agency adjudication by the TTAB and agency review by the Federal Circuit do not meet the standards mandated by the Administrative Procedure

Act (APA) in that: (1) the agency failed to provide a reviewable opinion by not providing a concrete factual record, not providing precise legal standards, and not articulating the reasons for its decisions; and (2) the reviewing court, the Federal Circuit, failed to adhere to its restricted scope of review by making factual findings that are independent of the agency record and depriving the agency of the deference afforded by Congress.

A. TTAB's Opaque Decision, Lacking Factfinding, Legal Standards, and Articulate Reasoning

Review of TTAB factfinding can only take place when the agency establishes the record and articulates the reasoning supporting its decision. *Packard Press v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358-60, 56 U.S.P.Q.2d 1351 1354 (citing *Dickson v. Zurko*, 527 U.S. 150, 165, 50 U.S.P.Q.2d 1930, 1937 (1999) (other citations omitted)). Broad brushstroke statements like the statement made by the TTAB —

> We have reviewed these objections, and have considered only that evidence which is relevant and properly before the board.

— are simply inappropriate to allow for judicial review by the Federal Circuit. App. 17a. The TTAB, in other words, is saying the only evidence it considered is the evidence it considered. Accordingly, remand is necessary, at a minimum, to determine what facts the Board considered in making its findings.

The Federal Circuit has recited this rule in remanding the *Packard Press* matter and ordering the TTAB to make the relevant findings. *Packard Press*, 227 F.3d at 1357, 56 U.S.P.Q.2d at 1354 (stating that the TTAB's statement that it [the TTAB] had "considered the marks in their entireties . . . absent further explanation" was simply insufficient for review).

The TTAB failed to definitively set out its rulings on issues as basic as the admissibility of evidence, so to establish the record. Both parties had made a substantial number of objections to the introduction of evidence to the point where separate

appendices were necessary to establish the grounds for such objections — many on the relevance of RHL's press regarding a foreign hotel as well as registrations that were obtained without use in United States commerce. In total the briefs at the TTAB comprised 14 pages of argument and 35 pages of appendices regarding what evidence should be properly before the Board in its deliberations. The extremely limited discussion in the TTAB opinion leaves the parties, and likely the Federal Circuit, uncertain as to what evidence was properly before the Board and what was considered.

For example, Shen had proffered evidence regarding a number of common law variations of its RITZ mark. Those marks included Shen's RITZ STERLING, RITZ ROYALE, RITZ SUPREME, and RITZ CLASSICS, among others. It is utterly impossible to determine from the TTAB's opinion whether this evidence was made part of the record and considered by the Board or the Federal Circuit in their "commercial impression of the mark" analysis. Judicial review cannot take place without some TTAB ruling on this issue.

Due to the TTAB's silence as to what comprised the record, the Federal Circuit made its own factual findings without a clear record set by the TTAB. This *de novo* factfinding is contrary to the mandate of APA Section 706(2)(E).

B. The Reviewing Court / Federal Circuit as the Factfinder.

In reviewing the TTAB's Opinion, the Federal Circuit improperly made many factual findings that were not made by the Board.

> Judicial review under the substantial evidence standard can only take place when the agency explains its decisions with sufficient precision, including the underlying factfindings and the agency's rationale. Only then can this court engage in reasoned review of agency decision making, and thus provide the deference that

> this court must properly give to the PTO's factual determinations.

Packard Press, 227 F.3d at 1357 (citing *Zurko*, 527 U.S. at 165; *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000)).

However, the Federal Circuit disregarded this standard of review by making *ultra vires* factual findings on its own, when the TTAB failed to make required factfinding. For instance, the TTAB made no finding of fact regarding the meaning of Shen's RITZ mark. However, the Federal Circuit exceeded its scope of review by engaging in *ultra vires* factfinding stating that Shen's RITZ mark's meaning was "mundane". App. 10a. Moreover, the Federal Circuit's finding is contrary to established dictionary definitions, which judicial notice thereof should be taken.

It is unclear what standard the TTAB used to compare the marks, or whether the TTAB used any standard whatsoever. As such, it would be impossible for the Federal Circuit to review the TTAB's conclusion under the substantial evidence standard without exceeding the permissible scope of review. The proper approach was remand, but the Federal Circuit pushed on into factfinding territory.

The standard for comparing marks for similarity involves consideration of sight, sound and meaning. 3 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 23.22 (2004). It is not clear from the TTAB opinion what test was used and what facts, other than the few stated, were considered in performing the similarity analysis. As for meaning, the TTAB made no finding as to Shen's marks. Similarity inherently involves comparing two marks, and such analysis was not fully performed by the TTAB since it made no finding as to meaning of Shen's marks. The "psychological imagery evoked by the respective marks" may turn the similarity analysis one way or another. *See, e.g., Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 390 F.2d 724, 156 U.S.P.Q. 340 (C.C.P.A. 1968) (Smith J. dissenting); *Colgate Polmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (relying on

standard dictionary meanings to determine similarity in meanings of the respective marks).

Another example of this error is the Federal Circuit's factual finding that Shen's RITZ mark is weak, where, again, the TTAB made no finding of fact regarding the strength of Shen's RITZ mark. The TTAB neither provided a standard for strength of Shen's mark nor did the TTAB consider the relevant evidence in light of that legal standard. From a judicial review standpoint, it is utterly impossible to review because the legal standard was not established nor were factual findings made. *Packard Press*, 227 F.3d at 1358, 56 U.S.P.Q.2d at 1355 ("In order for correct appellate review to occur under our standard of review, the Board must take care to express clearly both the facts as it finds them and the law that it applies to the facts.").

Although the TTAB found Shen's mark not to be famous, and the Federal Circuit upheld the decision as supported by substantial evidence, the legal standard for fame differs from that of strength, involves different considerations, and involves differing factual findings. Compare *Two Pesos v. Taco Cabana, Inc.*, 505 U.S. 763, 768-75, 120 L. Ed. 2d 615, 112 S. Ct. 2753, 23 U.S.P.Q.2d 1081, 1084 (1992) (the test includes a consideration of the distinctiveness of the mark and placement within the spectrum from generic to arbitrary or fanciful) with *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002) ("[F]ame of a mark may be measured indirectly . . . by the volume of sales and advertising expenditures . . . and . . . length of time. . . ."). It does not follow lock step that a mark is weak simply because a mark is not famous. For these reasons the opinion of the Federal Circuit should be reversed, and the consolidated opposition should be remanded to the TTAB for a consideration that includes relevant finding as basic as the strength of the senior user's, Shen's, RITZ marks. Accordingly, a writ of *certiorari* is needed to remedy this important issue for both the parties here and other litigants.

C. Substantial Evidence Requires That The Board's Findings Be Given Substantial Deference by the Federal Circuit.

The TTAB made a reasoned finding of relatedness, on the record, premised on the finding that a consumer attending Applicant's RITZ cooking classes also may encounter Shen's RITZ goods, such as kitchen towels, dish cloths, aprons, barbeque mitts, potholders, napkins, and placemats, which the TTAB found to be complementary to Applicant's cooking classes. App. at 20a. The Federal Circuit, in reversing, provided that it "does not necessarily follow that the consuming public would understand those products to have originated from the same source." App. at 11a. However, the TTAB's decision is supported by substantial evidence since Applicant, the source of the cooking course services, is itself intending to sell to consumers goods that are complementary to its cooking course services. The goods of Applicant's applications clearly show that RHL seeks to sell goods that are complementary to cooking courses, namely, dinner plates, cups, saucers, serving pieces, and household glassware. The Federal Circuit failed to consider this, and therefore failed to afford the agency the deference in the findings that are in fact made and supported with articulate reasoning.

The standard of review permits a finding to stand even though that finding can possibly be second guessed by a reviewing court — so long as the opinion is supported with evidence as a reasonable mind might accept as adequate to support a conclusion. *See, e.g. In re Jolley*, 308 F.3d 1317, 1320 (Fed. Cir. 2002) (we will not find the Board's decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative); *Boucher v. Apfel*, No. 99-1906, 2000 U.S. App. LEXIS 29895 at *18 (6th Cir. 2000) ("it is not the role of this court to second-guess the ALJ's factual conclusions . . . 'even if there is substantial evidence in the record that would have supported an

opposite conclusion.'") (citations omitted); *B&J Oil & Gas v. FERC*, 353 F.3d 71, 77 (D.C. Cir. 1994) ("Although the substantial evidence standard 'requires more than a scintilla,' it 'can be satisfied by something less than a preponderance of the evidence.'") (citations omitted). The "'possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence.'" *In Re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (quoting *Consolo v. Federal Maritime Comm'n*, 383 U.S. 607, 620, 16 L. Ed. 2d 131, 86 S. Ct. 1018 (1966)).

CONCLUSION

The Court should grant Petitioner Shen's writ of c*ertiorari* in order to resolve unsettled questions of trademark law involving consideration of fame and strength of a mark where the Federal Circuit and the Second Circuit are divergent on these issues, to remedy the Federal Circuit's failure to follow its own established precedent of limiting a trademark application's goods description to what is stated in the application, and to remedy the Federal Circuit's clear failure to follow the standard of review mandated by the APA.

Respectfully submitted,

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APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED DECEMBER 17, 2004

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

04-1063, -1076
(Opposition Nos. 71,706, 72,817, 73,756, 74,517, 72,818, and 75,003)

SHEN MANUFACTURING CO., INC.,

Appellant,

v.

THE RITZ HOTEL LIMITED,

Cross Appellant.

DECIDED: December 17, 2004

Before MAYER, *Chief Judge*, SCHALL and PROST, *Circuit Judges*.

MAYER, *Chief Judge*.

Shen Manufacturing Co., Inc. ("Shen") appeals the decision of the Trademark Trial and Appeal Board, which dismissed Shen's oppositions to The Ritz Hotel, Limited's ("RHL") registration of: (1) PUTTING ON THE RITZ for shower curtains; (2) RITZ PARIS RITZ HOTEL and design for various items of dinnerware; and (3) RITZ PARIS RITZ

Appendix A

HOTEL and design for various floor and wall coverings. *Shen Mfg. Co. v. Ritz Hotel Ltd.*, Opposition Nos. 71,706, 73,756 and 74,517, respectively (TTAB Aug. 7, 2003) ("*Board's Opinion*"). RHL cross-appeals the board's decision sustaining Shen's opposition to RHL's registration of RITZ for cooking and wine selection classes and THE RITZ KIDS for ready-made and tailored clothing. *Board's Opinion*, Opposition Nos. 72,818 and 75,003, respectively. We affirm the board's dismissal of Opposition Nos. 71,706, 73,756 and 74,517; and reverse the board's decision sustaining Opposition Nos. 72,818 and 75,003.[1]

Background

RHL owns and operates The Ritz Hotel in Paris, France, which was opened in 1898 by Cesar Ritz. According to RHL, as well as a myriad of publications presented by RHL, The Ritz Hotel is one of the most luxurious and renowned hotels in the world. Aside from hotel and restaurant services, RHL has expanded into other industries, including the sale of coffee, tea, chocolates, drinking glasses and champagne. These products are sold under a variety of registered marks, such as RITZ, RITZ PARIS RITZ HOTEL and design, and HOTEL RITZ. Shen, on the other hand, sells kitchen textiles, such as dish towels, potholders, and aprons, in addition to a variety of other textile items including bathroom towels and ironing board covers. Shen has used the RITZ mark, which was derived from its founder's last name, John Ritzenthaler, since it began doing business in 1892.

1. Shen also appealed the board's dismissal of Opposition No. 72,817. Because RHL has abandoned the corresponding application, Shen's appeal is moot.

Appendix A

In 1984 and 1985, RHL applied to register the following marks: (1) PUTTING ON THE RITZ for shower curtains; (2) RITZ PARIS RITZ HOTEL and design for "dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, [and] household glassware"; (3) RITZ PARIS RITZ HOTEL and design for "carpets, rugs, floor mats and matting, linoleum for covering existing floors, [and] wall covering made of vinyl and plastic"; (4) RITZ for cooking and wine selection classes; and (5) THE RITZ KIDS for ready made and tailored clothing, including underwear, dresses, skirts, trousers, shirts, neckties, belts, gloves, hats, raincoats and galoshes. Shen opposed the registrations, arguing that RHL's use of "Ritz" would likely cause confusion based on three factors: (1) the strength of Shen's RITZ mark; (2) the similarity of RHL's marks to Shen's RITZ mark; and (3) the relatedness of the products covered by RHL's applications and those sold by Shen.

In 2003,[2] the board decided Shen's consolidated oppositions. The board dismissed Opposition No. 71,706, which challenged RHL's registration of PUTTING ON THE RITZ for shower curtains. In so doing, the board found that while shower curtains are closely related to Shen's products, namely bathroom towels, RHL's PUTTING ON THE RITZ mark is dissimilar to Shen's RITZ mark in terms of appearance, sound and commercial impression. The board likewise dismissed Opposition Nos. 73,756 and 74,517,

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2. RHL's applications languished at the United States Patent and Trademark Office ("PTO") for nearly two decades as the result of the parties' failure to move the applications and corresponding oppositions forward.

which challenged both of RHL's registrations of RITZ PARIS RITZ HOTEL and design. Again the board found that the goods described in RHL's applications were related to Shen's goods, but that the differences in the marks were sufficient to prevent any likelihood of confusion. In contrast, the board sustained Opposition No. 72,818 covering RITZ for cooking and wine selection classes, finding that there was a likelihood of confusion because cooking classes require the use of kitchen textiles. The board also sustained Opposition No. 75,003 regarding THE RITZ KIDS for clothing, finding that gloves are too related to barbeque mitts considering the similarity of the marks. Shen appealed the board's decision as to Opposition Nos. 71,706, 73,756 and 74,517; RHL cross-appealed the board's decision as to Opposition Nos. 72,818 and 75,003. We exercise jurisdiction pursuant to 28 U.S.C. § 1295(a)(4). *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1356 (Fed. Cir. 2000).

Discussion

We review the board's legal conclusions *de novo*, *In re Dixie Rest., Inc.*, 105 F.3d 1405, 1406 (Fed. Cir. 1997), and its findings of fact for substantial evidence, *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 1359 (Fed. Cir. 2001). Whether there is a likelihood of confusion is a question of law based on underlying facts, such as the similarity of the marks and the relatedness of the goods or services. *In re Dixie*, 105 F.3d at 1406.

The PTO may refuse to register a trademark that is so similar to a registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause

confusion, or to cause mistake, or to deceive. . . ." 15 U.S.C. § 1052(d) (Supp. 2004). *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973), established a test for determining whether there is a likelihood of confusion:

> In testing for likelihood of confusion . . . the following, when of record, must be considered: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark). (10) The market interface between applicant and the owner of a prior mark .... (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e.,

> whether *de minimis* or substantial. (13) Any other established fact probative of the effect of use.

Neither we nor the board, however, need consider every *DuPont* factor. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) ("While it must consider each factor for which it has evidence, the [b]oard may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods."). Instead, we are required only to consider those factors that are relevant. There are three such factors in this case: (1) the alleged fame of Shen's RITZ mark; (2) the similarity of the marks; and (3) the relatedness of the goods.[3] *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002).

Before undertaking a comparison of each set of marks, we address Shen's contention that its RITZ mark is famous and, therefore, entitled to enhanced protection. *See id.* at 1371 (noting that famous marks enjoy greater protection). In support of this argument, Shen offered evidence that: (1) its mark is arbitrary; (2) more than $5 million worth of products bearing Shen's RITZ mark are sold annually; (3) the RITZ mark has been used continuously since 1892; (4) Shen spends hundreds of thousands of dollars annually on advertising; and (5) products bearing Shen's RITZ mark are advertised nationally. *See id.* ("[F]ame of a mark may be measured

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3. We assume that the channels of trade and the sophistication of the purchasers are identical. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002) ("[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers.").

indirectly . . . by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident."). This evidence does not, however, justify a finding of fame. In *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569-70 (Fed. Cir. 1983), we found that the GIANT FOOD mark was famous based on its 45 years of use, sales in excess of $1 billion per year, extensive media exposure and prominent display on the facade of supermarkets. Likewise, we found in *Bose*, 293 F.3d at 1372, that the ACOUSTIC WAVE mark was famous based on 17 years of use, annual sales over $50 million, annual advertising in excess of $5 million, and extensive media coverage. Although Shen's RITZ mark has been in use for more than a century, it does not compare in terms of sales, advertising or media interest. Further, it cannot be said that Shen's mark enjoys the "extensive public recognition and renown" characteristic of a famous mark. *Id.* at 1371 (quotation marks omitted). Thus, the board's failure to find that Shen's RITZ mark is famous is supported by substantial evidence.

We now consider each set of marks in turn, beginning with Opposition No. 71,706, which the board dismissed. The two marks at issue are Shen's RITZ for bathroom towels and RHL's PUTTING ON THE RITZ for shower curtains.[4] The board found, and we agree, that bathroom towels and shower curtains are related goods. *Board's Opinion*, slip op.

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4. Although Shen asserts that it now uses its RITZ mark on shower curtains, it did not start this practice until after RHL's application. As such, it is not entitled to priority of use for RITZ on shower curtains. *See Person's Co. v. Christman*, 900 F.2d 1565, 1569 (Fed. Cir. 1990).

at 10. Because the goods are related, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992). As to the marks, the board found that PUTTING ON THE RITZ leaves the consumer with a distinct impression, specifically that of getting dressed up or of the song composed by Irving Berlin. *Board's Opinion*, slip op. at 10. Shen argues that this was error because it overemphasizes the relevance of the words "Putting on the" while simultaneously underemphasizing the use of "Ritz." In this vein, Shen contends that "Putting on the" has no significance aside from its use in conjunction with "Ritz." As such, "Ritz" is the only relevant portion of the mark and, therefore, RHL's mark is identical to Shen's mark.

While there are often discrete terms in marks that are more dominant and, thus, more significant to the assessment of similarity, *Giant Food*, 710 F.2d at 1570 (finding GIANT to be dominant in both marks), the law forbids the type of dissection proposed by Shen. *See Packard Press*, 227 F.3d at 1358 ("The ultimate conclusion of similarity or dissimilarity of the marks must rest on consideration of the marks in their entirety."); *see also In re Nat'l Data Corp.*, 753 F.2d 1056, 1059 (Fed. Cir. 1985). PUTTING ON THE RITZ, when evaluated as a whole, conveys a strong commercial impression. It conjures images of fancy, even swanky, ladies in full length gowns and gentlemen in tails and top hats congregating in a large Art Nouveau restaurant where an orchestra is about to start. This image, one of comfort, sophistication and wealth, resonates strongly with the buying public, leaving them with an impression unlike

that from Shen's RITZ mark, which, when used on kitchen textiles, invokes images, if any, of cleaning, cooking or manual labor generally. The two marks also differ in terms of sound and appearance. *See In re Coors Brewing Co.*, 343 F.3d 1340, 1343 (Fed. Cir. 2003). RHL's mark contains other words in addition to "Ritz," making both its visual appearance and pronunciation longer. Thus, we affirm the board's dismissal of Opposition No. 71,706 because the dissimilarity of the marks prevents a likelihood of confusion.

We now turn to Opposition Nos. 73,756 and 74,517, which the board also dismissed. Both of these oppositions challenged the registration of RITZ PARIS RITZ HOTEL and design, which is reproduced here.

The products covered in the first opposition include dinnerware, such as plates, cups, saucers and drinking glasses, in addition to cleaning items, such as steelwool and sponges. The second includes various types of floor coverings, such as carpets and rugs, as well as wall coverings. The board found that despite the relatedness of some of the products listed in the applications (e.g., sponges) to Shen's cleaning

towels, the marks are sufficiently different to avoid a finding of likely confusion. *Board's Opinion*, slip op. at 9. Shen argues that the board erred by giving too much weight to the disclaimed elements of RHL's mark, namely the term "Paris" in large font and the terms "Paris" and "hotel" that appear on the banner under the crest. The disclaimed elements of a mark, however, are relevant to the assessment of similarity. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993). This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed. *In re Nat'l*, 753 F.2d at 1059. Therefore, the board did not err by taking into account the reference in RHL's mark to a hotel in Paris, France.

RHL's mark is further differentiated by the crest and ribbon, which give the mark a particularly regal feel. The crest, ribbon and reference to Paris collectively give the commercial impression of royalty, old-world tradition and continental elegance, which differs from the more mundane impression imparted by Shen's RITZ mark. Aside from the distinct commercial impression left by RHL's mark, the appearance of the mark is also different from Shen's RITZ mark. *See Hewlett-Packard*, 281 F.3d at 1265. Shen's mark generally appears as simple block lettering or block lettering centered in a diamond, as reproduced here.

Thus, Shen's uncomplicated mark either has a different shape, a diamond as opposed to the half circle used by RHL, or no embellishment at all. Based on the differences between the RITZ PARIS RITZ HOTEL and design and RITZ marks, we affirm the dismissal of Opposition Nos. 73,756 and 74,517.

Next, we assess that portion of the board's decision sustaining Opposition No. 72,818, which relates to RHL's registration of RITZ for cooking and wine selection classes. The marks are identical; therefore, we focus our attention on the relatedness of the goods. The board found that RHL's cooking classes are related to Shen's kitchen textiles because "in providing cooking courses . . . it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders." *Board's Opinion*, slip op. at 6. Thus, the board based its finding of relatedness on the fact that "the services of applicant clearly require the use of certain of opposer's goods." *Id.*

That two goods are used together, however, does not, in itself, justify a finding of relatedness. "[T]he test is not that goods and services must be related if used together, but merely that that finding is part of the underlying factual inquiry as to whether the goods and services at issue . . . can be related in the mind of the consuming public as to the origin of the goods." *Packard Press*, 227 F.3d at 1358. Conversely, goods that are neither used together nor related to one another in kind may still "be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (comparing FRITO-LAY for snack foods to FIDO

LAY for dog treats). Therefore, although a student of RHL's cooking classes would undoubtedly use kitchen textiles, it does not necessarily follow that the consuming public would understand those products to have originated from the same source. For example, in *In re Coors*, 343 F.3d at 1341, we held that the board erred by finding that beer and restaurant services are related regardless of the fact that countless restaurants serve beer. On the other hand, we found that "distributorship services in the field of automotive parts" were related to service station oil and lubrication services. *In re Shell*, 992 F.2d at 1206 (comparing the use of RIGHT-A-WAY on both products). Likewise, we found that amplifiers (i.e., parts of sound systems) were related to complete sound systems. *Bose*, 293 F.3d at 1376 (comparing the use of ACOUSTIC WAVE with POWER WAVE). And, finally, we found that data processing services would be perceived by the purchasing public as related to computer hardware and consultant data processing services. *Packard Press*, 227 F.3d at 1358 (comparing HEWLETT-PACKARD with PACKARD TECHNOLOGIES).

Of these, the relationship between cooking classes and kitchen textiles is more akin to the relationship between restaurant services and beer. Cooking classes are not the same type of product as kitchen textiles: one is a service while the other is a tangible good. Nor are they the same category of product in the sense that snack foods and dog treats are. *See Recot*, 214 F.3d at 1329. In this sense, it would be more accurate to say that cooking classes are in the same category as language or pottery classes. Thus, aside from the fact that these goods are used together, there is no indication that the consuming public would perceive them as originating from

the same source. As a result, the board's finding of relatedness is not supported by substantial evidence. Having determined that cooking classes and kitchen textiles are not related, we likewise reverse the ultimate conclusion as to the likelihood of confusion. Although the marks are identical, the differences in the products as well as the weakness of Shen's mark lead us to dismiss Opposition No. 72,818.

Finally, we turn to Opposition No. 75,003 for THE RITZ KIDS, which was sustained by the board. The board found that THE RITZ KIDS was similar to RITZ because "the word THE is one of those words that has virtually no significance in distinguishing trademarks" and "the word KIDS . . . simply indicates that the particular item of apparel is designed for kids." *Board's Decision*, slip op. at 8. The board likewise found that gloves are "legally identical" to barbeque mitts based on the definition in *Random House Webster's Dictionary* (2001) of "mitt" as a type of glove. *Board's Decision*, slip op. at 7. In conclusion, the board commented that, "if a consumer were familiar with opposer's RITZ mitts, we believe that upon encountering applicant's mark THE RITZ KIDS for, among other goods, gloves, he or she would assume that they emanate from a common source." *Id.* at 8.

We cannot sanction the board's dissection of RHL's mark. *See In re Nat'l*, 753 F.2d at 1058 (holding that a "likelihood of confusion cannot be predicated on dissection of a mark"). While it is accurate that terms such as "the" and "kids" often have little impact on consumers, this is not universally true. In this case, for instance, "the" has elevated significance because of the well-known manner in which people refer to RHL as "*The* Ritz" or "*The* Ritz Hotel," but not as "Ritz" or

"Ritz Hotel." *See id.* at 1058-59 ("Without question, the descriptive or generic character of an expression . . . is pertinent to the issue of likelihood of confusion."). Therefore, "the" operates as an indicator of source in RHL's mark even though it has diminished importance in most other marks. And, while "kids" is undeniably used to indicate that the product is geared toward children, it distinguishes RHL's mark from Shen's; it is unlikely that consumers would mistakenly believe that Shen, the manufacturer of kitchen textiles, has expanded into children's clothing. In addition, the pronunciation of THE RITZ KIDS sounds like "The Rich Kids," leaving the impression of wealth, a concept tied strongly to RHL and not associated in any way with Shen's RITZ mark. Thus, taking into consideration the "appearance, sound, connotation, and commercial impression of the two marks," we reverse the board's finding that THE RITZ KIDS is similar to RITZ. *In re Coors*, 343 F.3d at 1343.

We also reverse the board's finding that gloves are related to barbeque mitts because it is not supported by substantial evidence. The mere fact that "mitt" is defined as a type of glove has no relevance to whether a consumer would believe that the two products emanate from the same source. *See Packard Press*, 227 F.3d at 1358. First, Shen's product is not a mitt, it is a *barbeque* mitt. It is designed to protect the hand from heat while cooking. While it covers the hand like a glove, it is better understood as a tool than as an article of clothing. The unrelatedness of RHL's and Shen's products is highlighted by comparing a similar set of goods: hard hats used by construction workers and fedoras. While both are hats that are used to cover the head, they have different purposes. The first is used for protection, just as a barbeque

mitt is, while the second functions to keep the head warm in addition to adding an air of style, just as ready made or tailored gloves do. The mere fact that both barbeque mitts and gloves are worn on the hands simply does not support a finding that consumers would associate these products with a common source. *See Recot*, 214 F.3d at 1329. The board's finding that RHL's and Shen's goods are related is reversed. Because THE RITZ KIDS is not similar to RITZ and gloves are not related to barbeque mitts, we likewise reverse the board's decision sustaining Opposition No. 75,003.

Conclusion

Accordingly, we affirm the decision dismissing Opposition Nos. 71,706, 73,756 and 74,517; and reverse the decision sustaining Opposition Nos. 72,818 and 75,003.

Costs

No costs.

AFFIRM-IN-PART AND REVERSE-IN-PART

APPENDIX B — OPINION OF THE UNITED STATES PATENT AND TRADEMARK OFFICE DATED AUGUST 7, 2003

Mailed: August 7, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Shen Manufacturing Company Incorporated v.
Ritz Hotel Limited

Consolidated Opposition Nos. 71,706; 72,817; 72,818; 73,756; 74,517; 74,778; and 75,003

Before Simms, Hanak and Bottorff, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

In 1984 and 1985 the Ritz Hotel Limited (applicant) filed seven applications seeking to register marks consisting of or containing the word RITZ for various goods and services.

Thereafter, Shen Manufacturing Company Incorporated (opposer) filed seven Notices of Opposition alleging that applicant's use of its marks in connection with its goods and services would be likely to cause confusion with opposer's mark RITZ and design which it had used continuously since various dates (the earliest being 1892) for various products. Opposer alleged that all of its uses of RITZ and design long predated any first use dates claimed by applicant.

Appendix B

Applicant filed answers which denied that the contemporaneous use of any of its seven marks for their respective goods and services were likely to cause confusion with respect to opposer's mark for its goods. By an order of this Board dated April 25, 2001 the seven oppositions were consolidated. Both parties filed briefs and were present at a hearing held on March 20, 2003.

Applicant has raised numerous evidentiary objections. To a lesser extent, so has opposer. We have reviewed these objections, and have considered only that evidence which is relevant and properly before this Board. However, having said the foregoing, three objections raised by applicant deserve special comment.

First, at pages 15 and 16 of its brief, applicant contends that "Shen [opposer] has offered testimonial deposition testimony and evidence at trial concerning the use of RITZ marks other than those pleaded in the notices of opposition." In its Notices of opposition, opposer made specific reference to its RITZ and design mark, as shown below.

During the course of this proceeding, opposer's counsel (as well as applicant's counsel) repeatedly referred to opposer's mark as RITZ per se, without any mention whatsoever of its diamond design element. Thus, we hold that applicant has waived its objections to opposer's uses of RITZ per se.

However, having said the forgoing, we note that our ruling really constitutes a "distinction without a difference." In essence, opposer pled rights in RITZ surrounded by a very

simple geometric shape, namely, a diamond. It has long been held that such simple geometric background shapes have no trademark significance in that the public rarely takes notice of them. 1 *McCarthy on Trademarks and Unfair Competition*, Section 7:29 at page 7-68.7 (4th ed. 2002). An excellent example of this principle is found in *In re Hyper Shoppes*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988). In finding a likelihood of confusion between applicant's mark BIGG'S TRUE MINIMUM PRICING surrounded by a rectangle for grocery store services and the cited mark BIGG'S surrounded by an oval for furniture, the Court did not even discuss the presence of the rectangle or the oval. Hence, in our likelihood of confusion analysis, we will assume that opposer's mark is essentially RITZ per se.

Second, there is, as pointed out at pages 15 to 17 of applicant's brief, a dispute as to which goods opposer has established prior trademark rights. However, with one exception – shower curtains, to be discussed later – there is no dispute, as applicant acknowledges at page 16 of its brief, that opposer has established prior trademark rights in RITZ for dish cloths, kitchen towels, bathroom towels, toaster covers, textile placemats, napkins, potholders, barbeque mitts, aprons, and cleaning and polishing cloths. For our various likelihood of confusion considerations, the forgoing admission is sufficient, although we should add that the record reflects that opposer has established prior rights in the mark RITZ for a number of other related products.

Third, at footnote 12 at page 18 of its brief, applicant raises for the first time a defense under *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA

1969). Not only did applicant fail to plead a *Morehouse* defense, but said defense was not tried by the explicit or implicit consent of the parties. Hence, we will not consider this defense.

We now turn to the merits of the oppositions. Applicant seeks to register RITZ in typed drawing form for "providing courses of instruction in cooking, meal preparation and wine selection" (Ser. No. 73/499,080, Op. No. 72,818) and for "threads for use in textiles" (Ser. No. 73/549,463, Op. No. 74,778). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1978) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the characteristics of the goods [and services] and differences in the marks.").

Considering first the marks, they are essentially identical. As previously noted, there is no meaningful distinction between RITZ and RITZ enclosed within a simple geometric shape such as a diamond. Thus, the first *Dupont* "factor weighs heavily against applicant" because applicant's mark is essentially identical to opposer's mark. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Turning to a consideration of opposer's goods and applicant's goods and services, we note that because the marks are essentially identical, their contemporaneous use can lead to the assumption that there is a common source

"even when [the] goods or services are not competitive or intrinsically related." *In re Shell Oil Co.*, 922 F.2d 1204, 26 USPQ 1687, 1689 (Fed. Cir. 1993).

However, in this case, we find that certain of opposer's goods are clearly related to providing courses of instruction in cooking and meal preparation, and threads for use in textiles. Obviously, in providing cooking courses (applicant's services) it would be necessary that one make use of kitchen towels, dish cloths, aprons, barbecue mitts and potholders. After having prepared the food, one would need napkins and placemats. Accordingly, given the fact that the marks are virtually identical and the services of applicant clearly require the use of certain of opposer's goods, we find that there exists a likelihood of confusion.

As for applicant's RITZ threads for use in textiles, even if we make the assumption (not established by applicant) that such threads are only purchased by professional buyers, nevertheless, we find that such professional buyers who are aware of opposer's RITZ dish cloths, kitchen towels, napkins, cleaning cloths, textile placemats, polishing cloths and bathroom towels would assume that both threads for textiles and the finished products emanated from a common source. We recognize that professional buyers of threads for textiles are sophisticated. However, no degree of sophistication would enable even a professional to distinguish between essentially identical marks. Hence, we find that there exists a likelihood of confusion.

As for applicant's application Ser. No. 73/572,795 (Op. No. 75,003) for THE RITZ KIDS in typed drawing form

for, amongst other goods, gloves, we likewise find that there exists a likelihood of confusion with opposer's mark RITZ and simple diamond design. To begin with, we note that applicant's Class 25 application for THE RITZ KIDS includes "gloves" of all types, including ready made and tailored. A "mitt" is defined as a typed of glove. *Random House Webster's Dictionary* (2001). Because the goods are in part legally identical, "the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ 1698, 1700 (Fed. Cir. 1992). Whether mitts (some of opposer's goods) are related to other of applicant's Class 25 goods is irrelevant for our likelihood of confusion analysis. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). In considering applicant's mark THE RITZ KIDS, we note that the word THE is one of those words that has virtually no significance in distinguishing trademarks. *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). As for the word KIDS, it is clear that this word simply indicates that the particular item of apparel is designed for kids. Accordingly, if a consumer were familiar with opposer's RITZ mitts, we believe that upon encountering applicant's mark THE RITZ KIDS for, among other goods, gloves, he or she would assume that they emanate from a common source. Hence, the opposition is sustained as to applicant's Class 25 goods. Because opposer only opposed the Class 25 goods, it is not sustained as to the other classes. See page 7 of this Board's order of April 25, 2001.

As for applicant's applications to register RITZ PARIS RITZ HOTEL and design shown below for "dinner plates of

porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steelwool, household glassware; namely, tumblers, goblets and juice glasses" (Ser. No. 73/518,941, Op. No. 73,756) and for "carpets, rugs, floor mats and matting, linoleum for covering existing floors, wall covering made of vinyl and plastic" (Ser. No. 73/518,946, Op. No. 74,517), we simply note that this mark and opposer's mark are distinctly different in appearance, pronunciation and especially meaning. Put quite simply, applicant's mark conjures up a hotel in Paris, more specifically, the world famous Ritz Hotel. Thus, despite the fact that certain of opposer's goods (cleaning and polishing cloths) and certain of applicant's goods (household sponges and brushes) are very similar in terms of their functions, we nevertheless find that given the significant disparity in the marks, there exists no likelihood of confusion.

We turn now to application Ser. No. 73/514,805 (Op. No. 71,706) for PUTTING ON THE RITZ in typed drawing form for "shower curtains." To begin with, we note that while opposer has now made use of its mark RITZ for shower curtains, said use did not occur prior to applicant's priority date. Hence, the closest goods to shower curtains for which opposer has established priority are bathroom towels. Clearly, bathroom towels and shower curtains are related goods. However, put quite simply, the mark PUTTING ON THE RITZ conjures up images of getting well dressed up, or to older individuals such as myself, the legendary song *Puttin' on the Ritz* composed by Irving Berlin. We find that the differences in the marks outweigh the similarities in the goods (shower curtains and bathroom towels) such that there is no likelihood of confusion.

Appendix B

Finally, with regard to applicant's application seeking to register CESAR RITZ (Ser. No. 73/499,264, Op. No. 72,817) for "educational services; namely, conducting courses of instruction in cooking," we find that this mark is dissimilar enough from opposer's mark RITZ such that there is no likelihood of confusion. We recognize that previously we found confusion between opposer's mark RITZ and applicant's mark RITZ for cooking courses. Nevertheless, we find that the presence of CESAR in applicant's mark is sufficient to distinguish it from opposer's mark such that there is no likelihood of confusion. While by no means the dispositive factor, we note that CESAR is the first word in applicant's mark and this is "a matter of some importance since often it is the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products v. Nice Pak Products*, 9 USPQ2d 1825, 1827 (TTAB 1988) .

Decision: The oppositions are sustained with regard to opposition Nos. 72,818 and 74,778 (RITZ) and Op. No. 75,003 (THE RITZ KIDS). The other four oppositions are dismissed.

APPENDIX C — REQUEST FOR ORAL HEARING OF THE UNITED STATES PATENT AND TRADEMARK OFFICE DATED OCTOBER 2, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Opposition No. 71,706
Opposition No. 72,817
Opposition No. 72,818
Opposition No. 73,756
Opposition No. 74,517
Opposition No. 74,778
Opposition No. 75,003

Shen Manufacturing Company, Incorporated

v.

Ritz Hotel Limited

Nancy L. Omelko, Interlocutory Attorney:

This case now comes up on the following motions:

a. Applicant's contested motion (filed June 28, 2001) for leave to take a testimonial deposition outside of the scheduled testimony period or, in the alternative, to extend applicant's testimony period by thirty (30) days;

b. Opposer's contested motion (filed July 2, 2001) to amend notices of opposition pursuant to Rule 15(a) Federal Rules of Civil Procedure 37 C.F.R. § 2.107;

c. Applicant's contested motion (filed July 30, 2001) to strike portions of opposer's notice of reliance;

d. Applicant's contested objection (filed August 14, 2001) of filing of reply brief submitted in support of opposer's motion to amend;

e. Opposer's contested motion (filed February 12, 2002) to file an over-size reply brief or, in the alternative, motion for extension of time to file a substitute 25-page reply brief; and

f. Opposer's request (filed February 19, 2002) for oral hearing.

We turn first to Applicant's motion for leave to take a testimonial deposition outside of the scheduled testimony period or, in the alternative, to extend applicant's testimony period by thirty days. Applicant contends that because of the prior commitments of applicant's president, who resides in France, applicant's president will not be available for a testimonial deposition during applicant's testimony period; but applicant's president will travel to the United States twelve days after applicant's testimony period is set to close for such deposition.

In response, opposer argues that applicant refused to make its president available for a testimony deposition notice

by opposer for July 29, 1999; and that applicant refused to produce the witness on the basis that applicant's president was a foreigner and not required to submit to federal rules. Furthermore, the Board stated in its last order that "[f]urther delay of this consolidated case by either party will be looked on with disfavor."

The Board has admonished the parties that it will not permit further delays in this consolidated proceeding. Applicant has provided no information that would convince the Board that further delays are warranted. Accordingly, applicant's motion to take the testimony deposition of applicant's president outside applicant's testimony period, or to extend applicant's testimony period, is denied.

We turn next to applicant's objection to opposer's filing of a reply brief in support of opposer's motion to amend. We are construing this motion as a motion to strike opposer's reply brief in support of opposer's motion to amend. Applicant objects on the basis that opposer's reply brief is merely a reiteration of opposer's moving brief. In response, opposer argues that its reply brief "addresses and discloses facts omitted by Applicant in its brief."

We agree with opposer that its reply brief is more than a mere reiteration of opposer's moving brief. As such, applicant's motion to strike opposer's reply brief in support of opposer's motion to amend is denied.

Accordingly, we have considered opposer's arguments set out in its reply brief for the purpose of deciding opposer's motion to amend its notice of opposition.

Appendix C

We will now decide the merits of opposer's motion to amend its notice of opposition. Opposer has indicated that the amended notice adds a registration for "substantially the same goods." In response, applicant argues that the motion is untimely and prejudicial to applicant.

Specifically, applicant argues that the motion was filed on the second-to-last day of opposer's testimony period, nearly two years after the registration in question was issued, and more than two months after the Board issued its resumption order.

In reply, opposer argues that the motion is timely and that applicant will not be prejudiced because the proposed amendment does not set forth a new or additional basis for relief; but rather clarifies the matter pleaded. Opposer argues that not only has applicant known about the registration in question, but has also introduced and used the application at a testimony deposition.

Although opposer has referred to its motion to amend as one submitted under Fed. R. Civ. P. 15(a), it is apparent that the motion should rather be made under Fed. R. Civ. P. 15(b), which pertains to amendments to conform to the evidence.

When issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the

result of the trial of these issues. See, for example, Fed. R. Civ. P. 15(b); *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usollini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ2d 1501 (TTAB 1993); and Beth A. Chapman, *TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff*, 81 Trademark Rep. 302 (1991).

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. See, for example, *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984).

In as much as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a Fed. R. Civ. P. 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing. *See Devries v. NCC Corp.*, 227 USPQ 705 (TTAB 1985).

Accordingly, opposer's motion to amend its pleadings is deferred until final hearing.

As for applicant's motion to strike portions of opposer's notice of reliance filed on July 5, 2001, we note that under

the heading of Miscellaneous Matters, in its order dated April 25, 2001, the Board stated, among other things:

> Needless to say, opposer as plaintiff in the oppositions, is responsible for organizing and presenting its record for trial and to be clear what has been or will be submitted as evidence in this consolidated case.

Under "Notice of Reliance" dated July 5, 2001, opposer submitted, among other things, "[f]or the convenience of the Board . . . a single submission of all testimony, exhibits used thereat, and other evidence upon which Opposer relies in these Opposition proceedings, now consolidated. Copies of these documents are provided. . . ."

Applicant has moved to strike portions of this notice of reliance, namely Exhibits 1 through 7 of opposer's notice of reliance dated July 5, 2001, arguing that these exhibits are testimony depositions and, as such, are not proper subject matter for a notice of reliance, but must be submitted in accordance with Trademark Rule 2.123.

Opposer argues that the motion is meritless since the testimony has already been introduced into the evidentiary record prior to the filing date of opposer's July 5, 2001 notice of reliance; and that the July 5, 2001 submission which contained the testimony depositions submitted as exhibits 1 through 7 of opposer's three volume evidentiary compilation were included for the convenience of the Board. Applicant, in its reply, indicates that the key issue is whether there is any procedural basis for opposer to file testimonial deposition transcripts via a notice of reliance.

Appendix C

Trademark Rule 2.125(c) requires that a copy of the transcript and any exhibits thereto shall be filed with the Board. The standard has been a flexible one and, as a practical matter, has meant that a transcript and any exhibits thereto are considered to have been promptly filed if they are submitted at any time prior to the final hearing of the case by the Board. *See Hewlett-Packard Co. v. Human Performance Measurement Inc.*, 23 USPQ2d 1390 (TTAB 1991).

Furthermore, we note that the prosecution histories entered in the physical file for certain cases in this consolidated proceeding indicate the following with respect to opposer's exhibits 1 through 7 of its notice of reliance:

1. Exhibit 1 has been entered in the prosecution history of Opposition No. 71,706 as No. 13, showing a date of June 23, 1986, for "testimony of plaintiff";

2. Exhibit 2 has been entered in the prosecution history of Opposition No. 72,817 as No. 17, showing a date of September 8, 1986, for "testimony for plaintiff of Howard Steidle";

3. Exhibit 3 has been entered in the prosecution history of Opposition No. 72,817 as No. 81, showing a date of September 20, 1999, for "testimony of Robert Steidle";

4. Exhibit 4 has been entered in the prosecution history of Opposition No. 73,756 as No. 52, showing a date of September 20, 1999, for "continued oral dep of Robert M. Steidle";

5. Exhibit 5 has been entered in the prosecution history of Opposition No. 74,517 as No. 58, showing a date of September 20, 1999, for "testimony of Howard Steidle"; and

6. Exhibit 6 has been entered in the prosecution history of Opposition No. 72,817 as No. 59, showing a date of September 20, 1999, for "testimony of Robert Steidle".

Opposer indicates that with respect to Exhibit 7, "Applicant's counsel attended Mr. Steidle's September 1, 1999 testimony deposition and cross-examined Mr. Steidle. While the transcript of Mr. Steidle's September 1, 1999 testimony deposition does not appear as an entry in the prosecution history, Thomas G. Oakes Association confirms and certifies that said transcript was timely mailed to the Board for filing in opposition no. 71,706. Opposer has attached the declaration of Thomas Oakes.

Inasmuch as opposer has established that Exhibits 1 through 7 were properly filed with the Board; and that the documents filed under notice of reliance dated July 5, 2001 were merely resubmissions, applicant motion to strike exhibits 1 through 7 is denied.

Turning now to opposer's motion to file a reply brief that exceeds the page limit set forth in Trademark Rule 2.128, we note that the motion has been fully-briefed by the parties. Further, the Board notes that applicant filed its brief on the case after its time closed for filing its brief; and opposer filed its reply brief after its time closed for filing its reply brief.

Neither party has objected, and thus has waived any right to object, to the late filing of these briefs and, therefore, they are considered of record. Furthermore, at this late date, the Board will not permit the filing of a motion to strike either brief as untimely.

Opposer maintains that this consolidated proceeding is complicated because it involves six different trademarks used in connection with seven different identifications of goods. Opposer further maintains that applicant, in its brief, included fourteen pages devoted to evidentiary objections, which opposer must also respond to.

In response, applicant argues that the although the proceeding has been going on for a considerable length of time, "both parties were more than able to discuss their arguments in full in their principal briefs within the prescribed page limits" and "[a]pplicant's objections to some of the evidence fall within a limited range of conceptual categories and do not require a lengthy, point-by-point response."

Applicant further argues that opposer includes objections to various items of evidence offered by applicant, which opposer did not object to in opposer's principal brief; and opposer includes new issues, such as discussions of reverse confusion, and that applicant did not file its application in good faith. Applicant does not object to opposer's motion to file a substitute reply brief.

Opposer replies, to add, among other things, that opposer's evidentiary objections were properly made and

timely proffered and opposer further contends that it introduced no new issues, but merely rebutted applicant's arguments in applicant's brief.

It is the view of the Board that opposer has not shown good cause for exceeding the twenty-five page limit in its reply brief. Accordingly, opposer's motion to file a brief that exceeds the page limit set forth in Trademark Rule 2.128 is denied; and opposer is allowed until **fifteen days** from the date of this order to file a reply brief that complies with Trademark Rule 2.128.

The request for oral hearing is noted. An oral hearing will be scheduled in due course.

APPENDIX D — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED MARCH 8, 2005

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

04-1063, -1076
(Opposition Nos. 71,706, 72,817, 73,756, 74,517, 72,818, and 75,003)

SHEN MANUFACTURING CO., INC.,

Appellant,

v.

THE RITZ HOTEL LIMITED,

Cross Appellant.

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

Appendix D

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on March 15, 2005.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: March 8, 2005

APPENDIX E — RELEVANT STATUTES

5 U.S.C. § 706

Section 706. Scope of review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

15 U.S.C. § 1052

Section 1052. Trademarks registrable on principal register; concurrent registration

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods

and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of Title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be

issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this

title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which when used would cause dilution under section 1125(c) of this title may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which when used would cause dilution under section 1125(c) of this title may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

Appendix E

15 U.S.C. § 1063

Section 1063. Opposition to registration

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be

issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

Table I

Summary of Oppositions

Opp. No.	Applicant's Mark	Applicant's Goods/Services	App/n. Filing Date	Sec. 44	Sec. 44 Date	Date of First Use
71,706	PUTTING ON THE RITZ JA000022.008 JA000022.151	IC 24. US 42. Shower curtains.	73/514,805	12/21/84	No	- 05/01/84
72,817	CESAR RITZ JA000022.171 JA000022.035	IC 41. US 107. Educational services; namely, conducting courses of instruction in cooking.	73/499,264	09/13/84	Yes	04/17/80
72,828	RITZ JA000022.060 JA000022.193	IC 41. US 107. Providing courses of instruction in cooking, meal preparation, and wine selection.	73/499,080	09/12/84	Yes	05/04/84

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Opp. No.	Applicant's Mark	Applicant's Goods/Services		App/n. Filing Date	Sec. 44	Sec. 44 Date	Date of First Use
73,756	RITZ PARIS RITZ HOTEL JA000022.083 JA000022.215	IC 21. US 2, 29,4,30,33,40. Dinner plates of porcelain or earthenware, cups, saucers and serving pieces of porcelain, hair combs, household sponges, household brushes, steel wool, household glassware; namely, tumblers, goblets and juice glasses.	73/518,941	01/23/85	Yes	09/07/84	
74,517	RITZ PARIS RITZ HOTEL JA000022.104 JA000022.233	IC 27. US 20, 42. Carpets, rugs, floor mats and matting, linoleum for covering existing floors, wall coverings made of vinyl and plastic.	73/518,946	01/23/85	Yes	09/21/84	-

Opp. No.	Applicant's Mark	Applicant's Goods/Services		App/n. Filing Date	Sec. 44	Sec. 44 Date	Date of First Use
75,003	THE RITZ KIDS JA000022.125 JA000022.269	IC 33. US 47, 49. Wine, champagne, brandy, cognac and armagnac. IC 25. US 39. Ready made and tailored clothing; namely, underwear, dresses, skirts, trousers, shirts, neckties, belts, gloves, hats, tights, boots, shoes and slippers for men, women and children, and waterproof clothing; namely, men's and women's raincoats, rain hats and galoshes. IC 29. US 46. Meat, poultry, meat extracts, fresh frozen fruits and vegetables, fruit preserves, edible oils, pickles, and frozen entrees consisting of meat, fish, poultry or game.	73/572,795	12/10/85	Yes	06/17/85	-

Appendix G

Appendix Table IIa

Shen's RITZ Marks Under Common Law

RITZ	RITZ and Design
RITZ PRO SERIES	RITZ ESSENTIALS
RITZ STERLING	RITZ ROYALE
RITZ SUPREME	RITZ CLASSICS
RITZ DESIGN LINE	(JA465-72)

Appendix G

Appendix Table IIb

List of Shen's Goods (Non-Exhaustive) Sold in U.S. Commerce Under its RITZ Marks

(JA61, 70, 71, 72, 114, 115, 116, 121, 122, 123, 124, 456-494, 561)

appliance covers
anti-microbial cloth
aprons
bath towels
bathroom scrubbing cloths
beach towels
baker's pad
baker's mitt
baker's glove
baker's arm sleeve
baker's towel
bar mop towels
cheese cloth
cook's towel
chef's hat
chef's cap
chef's jacket
chef's skillet handle
cut resistant kitchen glove
cleaning cloths
dish cloths
dish towels
dust cloths
flour sack towels
hand towels
glass towels
ironing board covers
laundry bag
kitchen towels
napkins
oven mitts
place mats
polishing cloths
pot holders
scouring cloths
seat cushions
shower curtains
table cloths
tile cloths
tub mats
wash bag
wash cloths
window cloths

Appendix F

Opp. No.	Applicant's Mark	Applicant's Goods/Services	App/n. Filing Date	Sec. 44	Sec. 44 Date	Date of First Use
		IC 16. US 37, 38. Writing paper and envelopes, pens, pencils, engagement books, file folders, blotter holders and playing cards.				
		IC 14. US 27. Watches, clocks and parts thereof.				

Table II

Shen's Ritz Marks

MARK	REGISTRATION NO.	GOODS/SERVICES
RITZ and design JA000022.216	1,360,630	IC 24. US 42. Dish cloths, kitchen towels, toaster covers, textile place mats, napkins, potholders and barbeque mitts.
RITZ and design JA000022.161	125,512	US 4. Cleaning and polishing cloths, abrasive, detergent and polishing materials.
RITZ and design JA000022.159	1,231,981	IC 25. US 39. Aprons.
RITZ JA000022.157	2,288,326	IC 22 and 24, US 1,2,7,19,22,42 and 50. Laundry bags and Clothespin bags. Dish cloths, kitchen towels, bathroom towels, ironing board pads and covers, toaster covers, place mats, napkins, pot holders, oven mitts, and barbeque mitts.